TAY SIEW KIAT

v.

WAN LEONG CHAI

HIGH COURT MALAYA, KUALA LUMPUR
VINCENT NG J
[SUIT NO: D1-22-2228-2000]
8 APRIL 2004

CIVIL PROCEDURE: *Contempt of court - Breach of interim injunction order - Defendant sold tablecloths that purportedly had plaintiff's registered design in breach of order - Failure to incorporate precise design and get up of impugned tablecloth in consent order - Whether a fatal omission in contempt proceedings*

This was an application by the plaintiff to cite the defendant for contempt of court for having breached an interim injunction order entered into by consent of both parties. The interim injunction order restrained the defendant from selling tablecloths that had the plaintiff's registered design pending the defendant's application to set aside the plaintiff's registered design and the plaintiff's application for, *inter alia,* a permanent injunction against the defendant. The plaintiff alleged that the industrial design on the tablecloths for sale by the defendant after service of the consent order was similar to that of the plaintiff's registered industrial design.

Held (dismissing the application):

[1] The current complaint was for breach of the consent order and not for the similarity of design of the tablecloth. To commit a person to prison for contempt, the terms and nature of the injunction alleged to be willfully disobeyed must be construed narrowly and must necessarily be quite unambiguous and unequivocal. Also, it is an offence of a criminal character and the breach of the terms of the order must be proved beyond reasonable doubt. In such contempt proceedings it is incumbent upon the court to embark upon a three-step approach. Firstly, to examine the precise nature and ambit of the order made. Secondly, to ask whether there was a contemptuous or contumelious breach of order. Thirdly whether the breach occurred after the alleged contemptnor was served with the order which order must essentially bear the penalty endorsement. (p 350 b-d & e-h)

[2] The precise nature and get up of the impugned tablecloth was not exhibited or appended in the consent order. Exhibiting the tablecloth in the affidavit supporting the application was insufficient. In a charge of criminal contempt, it was the very court order rather than the cause papers that the court should have exclusive reference to. Consequently, this court was left in the dark as to the precise nature of the alleged breach by the defendant upon that the contempt proceedings was founded. The plaintiff's failure to incorporate in the consent order the precise design and get up of the impugned tablecloth that was the subject matter of the consent order was a fatal omission in the contempt proceedings. (pp 351 f-h & 352 a)

Case(s) referred to:

Bondor Pty Ltd & Ors v. National Panels Pty Ltd [1990] ALR Vol 98 ***(refd)***
Breville Europe v. Thorn EMI Domestic Appliances Ltd [1995] FSR 77 ***(refd)***
Cow v. Cannon [1959] RPC 240 ***(refd)***
Dalgerty Australia Operations Ltd v. Seeley (FF) Nominees Pty Ltd [1985] 68 ALR 421 ***(refd)***
Firmagroup Australia Pty Ltd v. Byrne & Davidson Doors (Vic) Pty Ltd [1987] 73 ALR 321 ***(refd)***
Holdsworth v. Mc'Crea [1867] LR 2 HL 380 ***(refd)***
Hothersall v. Moore [1802] RPC Vol IX 27 ***(refd)***
Iberian Trust Ltd and Investment Co Ltd [1932] 2 KB 87 ***(refd)***
Interlego AG v. Tyco Industries Inc & Ors [1989] 1 AC 217 ***(refd)***
PA Thomas & Co & Ors v. Mould & Ors [1968] 2 QB 917 ***(refd)***
Polygram Records Sdn Bhd & Ors v. Phua Tai Eng [1986] 2 MLJ 87 ***(refd)***
Re Bramblevale Ltd [1970] Ch 128 ***(refd)***
Redland Tiles Ltd & Ors v. Kua Hong Brick Tile Works [1966] 2 MLJ 62 ***(refd)***
Tiu Shi Kian v. Red Rose Restaurant Sdn Bhd [1984] 1 CLJ 325; [1984] 2 CLJ (Rep) 543 HC ***(refd)***
UPL Group Ltd v. Dux Engineers Ltd [1989] 3 NZLR 135 ***(refd)***

Legislation referred to:

Industrial Design Act 1996, ss. 3, 10(1), 12(1), (2)(a), 27(a)

Other source(s) referred to:

The Modern Law of Copyright and Design, 2nd edn, vol 1, p 1061

For the plaintiff - Edwin Lim (YY Ho); M/s WA Lau & Partners
For the defendant - M Pani; M/s Kim Seng Sinnu & Co

Reported by Usha Thiagarajah

JUDGMENT

Vincent Ng J:

Preamble

The plaintiff had filed a writ action (encl. 1) against the defendant praying for, *inter alia*, injunction, discovery, damages and costs for infringing, attempt to infringe, passing off or attempt to pass off the industrial design no. MY 99-00186 of a table cloth registered in favour of the plaintiff. The plaintiff's claim was vigorously resisted by the defendant on the grounds, *inter alia*, that the design, pattern and number of curves of the defendant's table cloth is different from plaintiff's registered industrial design (see para. 5 of the defence). Nevertheless, as an interim measure, an interim injunction order was entered into by consent of both parties on 13 June 2001 (the consent order).

This is the plaintiff's application (encl. 47), seeking to cite the defendant for contempt of court for having breached the consent order.

On 21 March 2002, at the request of the solicitors for both parties this court recorded that the parties have unreservedly agreed to submit to the court's determination on encl. 47 based solely on affidavit evidence.

The Consent Interim Injunction Order

The consent order reads:

> … ADALAH DIPERINTAHKAN SECARA PERSETUJUAN bahawa:
>
> 1. Defendan, sama ada oleh pengkhidmat-pengkhidmat atau ejen-ejennya atau mana-mana daripada mereka atau selainnya dengan apa cara jua, disekat oleh injunksi interim daripada mencerobohi pendaftaran reka bentuk perindustrian no: MY 99-00186 iaitu eksibit "TSK-2" dalam kandungan 2 sehingga tarikh pendengaran pada 19hb Julai 2001. …

The consent order relates to the plaintiff's industrial design of a table cloth registered as no. MY 99-00186 and exhibited as 'TSK 2'. It is noteworthy that the consent order was perfected without any variation.

The Law On Industrial Design Cases

Albeit, it will only be pertinent later in the proceedings when encl. 10 is heard I propose to very briefly set out the law on industrial design cases and the submissions of counsel for both sides to illustrate how far amiss they were on the target in terms of the proper issues. In encl. 10, the

defendant sought under s. 27(a) to revoke the registration of the plaintiff's industrial design no. MY 99-00186 pursuant to s. 12(1), s. 12(2)(a) and s. 10(1) of the IDA on the grounds that the said design is not a new design and the plaintiff is not the original owner of same. (Incidentally, to obviate a multiplicity of appeals to the Court of Appeal which the parties are wont to do, as with my decision on encl. 47, I would later propose that encl. 10 be heard together with encl. 1 save that the decision on encl. 10 shall immediately precede the decision on encl. 1.)

Section 3 of the Industrial Design Act 1996 (IDA) defines industrial design as:

> features of shape, configuration, pattern or ornament applied to an article by industrial process or means, being feature which in the finished article appeal to and are judged by the eye, …

Relying on this provision, the plaintiff submitted that the registration of his industrial design afforded protection not only to the unique shape and or configuration of his table cloth but also the pattern and or the ornament of the cloth.

Counsel for the plaintiff quoted the following extract of Lindley LJ's judgment in *Clarke's Design* at p. 1061 in *The Modern Law of Copyright and Design* (2nd edn vol 1) *(Clarke's Design)*:

> … the design is for the shape of a thing, the distinction is reduced to the difference between the shape of a thing and a thing of that shape. A design applicable to a thing for its shape can only be applied to a thing by making it in that shape. A design for the shape of something is what is meant by section 60 when shape is in question: and a registered design for a shape of a thing is infringed if that thing is made in the shape shown by the registered design.

The *Clarke's Design* further refers to the case of *Cow v. Cannon* [1959] RPC 240 which held that the shape of a uniquely designed water bottle was protected by registered design. In the words of the author at p. 1268, it reads as follows:

> There is no reason why a proprietor should not claim design right in all aspects of the shape or configuration of his article which he believes could give him a commercial edge over his competitors. In particular, when it comes to suing a competitor for infringement he will be well advised to rely, individually and collectively, upon each of those separate aspects of shape or configuration which appear to have been copied by the competitor.

It was the plaintiff's contention that the definition in s. 3 is disjunctive and not conjunctive whereby a design can be registered if one of the elements of shape, configuration, pattern or ornament is satisfied. Thus, the registration of the plaintiff's design protects its unique shape and/or configuration as illustrated in exh. 'TSK2' and its novelty statement. The court's attention was also drawn to *Interlego A.G. v. Tyco Industries Inc. & Ors* [1989] 1 AC 217 where the Privy Council held, *inter alia*, that:

> In approaching the definition it is always to be borne in mind what is to be registered. It is a shape, configuration or pattern to be applied to a particular specified article and it is the shape or configuration of the whole article of which there is to be a commercial monopoly.

In *Redland Tiles Ltd & Ors v. Kua Hong Brick Tile Works* [1966] 2 MLJ 62, it was held that:

> The question whether a design which is alleged to infringe a registered design is or is not an infringement must be determined by eye alone. The court has to decide only whether the alleged infringement has the same shape or pattern …

Also in both *UPL Group Ltd v. Dux Engineers Ltd* [1989] 3 NZLR 135 and *Breville Europe v. Thorn EMI Domestic Appliances Limited* [1995] FSR 77, the court appeared to apply the similar test, that is to say, in assessing the infringement of design, it must be judged solely by eye, the eye of the customer who is going to purchase the article which has to be used in judging and in making the comparison between the alleged infringing article and the registered design.

The plaintiff's case is that the table cloths offered for sale by the defendant after service of the consent order and the said registered industrial design is so similar in shape and configuration or pattern that they are likely to confuse and therefore the defendant had committed an act of infringement and thereby breached the consent order.

The plaintiff's allegation was forcefully denied by the defendant, who averred that the consent order was recorded merely to maintain the *status quo* of the case pending the hearing of his own application to set aside the plaintiff's registration of the industrial design of the table cloth as in encl. 10. The defendant pointed out that the ambit of the order served only to prohibit him from selling the table cloth identified as exh. 'TSK2' in encl. 2 but not from carrying on his business of selling table cloths. **The defendant denied that the table cloths he sold were the same as exh. 'TSK2'**. (emphasis added)

The defendant relied upon the judgment of the Australian Federal Court in *Dalgerty Australia Operations Ltd v. Seeley (FF) Nominees Pty Ltd* [1985] 68 ALR 421 at 425 wherein Bollen J approved the test applied by the trial judge to determine whether a particular subject matter is infringing another, namely that:

> **The comparison is a question of fact for the eye to judge but an eye instructed as to the meaning and identity of the registered design and the features which are to be compared** … I must judge by my eye and instructed and assisted by the 'expert witnesses'. (emphasis added).

Counsel for the defendant further referred to *Hothersall v. Moore* [1802] RPC Vol IX 27 wherein Lord Bristowe relied on the judge's eye test of Lord Westbury in *Holdsworth v. Mc'Crea* [1867] LR 2 HL 380 and held that:

> … Whether, therefore, there is piracy or not, is **referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure, and ascertains whether they are or are not the same.** … if a design, as exhibited in a pattern, is filed and registered by an inventor, without any further limitation or description than that which is given by the design itself, **it protects the entire thing and the entire thing only, and the protection cannot, at pleasure, be made applicable one day to the entirety, and another day to the separate integral parts or elements of the entire design.** It must be considered that the protection of the statute is invoked for the entire thing that appears upon the register, and is applicable to nothing but an exact copy of the thing so registered. What appears to be registered, and is *de facto* and *de jure* registered, is the entirety of the pattern, and the registration is not capable of being made the subject of ambiguous claims …

And, buttressed the above authorities with words of Pincus J in *Bondor Pty Ltd & Ors v. National Panels Pty Ltd* [1990] ALR Vol 98 114 at 118, who intoned in no uncertain terms that no one has "a monopoly of what might be described as a category or family of designs, of quite different appearance, which have in common that they may be all reduced to one by appropriate expansions or shrinkings of relative dimensions". (See *Firmagroup Australia Pty Ltd v. Byrne & Davidson Doors (Vic) Pty Ltd* [1987] 73 ALR 321.)

In my opinion, both counsel were wholly off the mark – barking up the wrong tree – in their submissions as this court's current focus in the contempt proceedings should not be the 'unerring judge's eye' or 'instructed eye test' on comparison of designs, configuration or pattern as a whole or in separate parts, but rather the 'beyond reasonable doubt test' to determine whether a contempt has been committed. (Incidentally, I am of tentative opinion that the words 'that are likely to confuse and mislead' tends to indicate that the registered design and the alleged infringing article both ought to be looked at as a whole and the latter need not be 'an exact copy of the thing so registered'.) Surely, the current complaint logically concerns exclusively, the breach of the consent order rather than the similarity of design of the table cloth, bearing in mind that the acute similarity of the designs, configuration or pattern of the plaintiff's and defendant's table cloths has, at all material times been acutely disputed, which indeed necessitated this court's eventual adjudication on encl. 1. Thus, I shall now proceed to briefly discuss the law on contempt proceedings.

The Law On Contempt Proceedings

The law on contempt proceedings in civil cases is well settled. (See *Tiu Shi Kian v. Red Rose Restaurant Sdn Bhd* [1984] 1 CLJ 325; [1984] 2 CLJ (Rep) 543.)

To commit a person to prison for contempt, the terms and nature of the injunction, allegedly willfully disobeyed, must be construed narrowly (see *Iberian Trust Ltd and Investment Co Ltd* [1932] 2 KB 87) and must necessarily be quite unambiguous and unequivocal. See *P.A. Thomas & Co & Ors v. Mould & Ors* [1968] 2 QB p. 917. Mindful also, that as it is an offence of a criminal character the breach of the terms of the order must be proved beyond reasonable doubt. See *Re Bramblevale Ltd* [1970] Ch 128 at 317 where Lord Denning MR had this to say: "A contempt of court is an offence of a criminal character. A man may be sent to prison for it. It must be satisfactorily proved. To use the time honoured phrase, it must be proved beyond reasonable doubt." See also *Polygram Records Sdn Bhd & Ors v. Phua Tai Eng* [1986] 2 MLJ 87.

In such contempt proceedings it is incumbent upon the court to embark upon a three-step approach. Firstly, to examine critically, with a fine toothcomb, the precise nature and ambit of the order made. Secondly, to ask whether there was a contemptuous or contumelious breach of order. And, thirdly, whether the breach occurred after the alleged contemptnor was served with the order, which order must essentially bear the penalty endorsement.

Hence, in the current case, taking the approach as guided by the above two authorities and the three principles laid out by me, it is incumbent upon this court to first consider whether the interim injunction order dated 13 June 2001 entered by consent (the consent order) was couched in unambiguous and clear terms which are sufficient to affix criminal liability on the defendant should he commit breach thereof. It is not disputed that the consent order bearing the penalty endorsement was duly served on the defendant on 4 July 2001.

The consent order only enjoins in the following language:

> The defendant by his employees or his agents or anyone of them in whatever manner be restrained through an interim injunction from passing off of the industrial design registered as no. MY 99-00186 as shown in Exhibit 'TSK-2' in Enclosure 2 until the date of the disposal on 19th July 2001 of Enclosure 10.

Under the circumstances, I could, while perhaps indulging in the realm of surmise, speculate that the following scenario may have transpired between the parties shortly before the record of the consent order. The plaintiff accused the defendant of selling, among other goods including various table cloths, two table cloths that bear sufficient similarity in design and getup to the plaintiff's table cloth registered under industrial design no. MY 99-00186 exhibited as 'TSK2'. The defendant denied the charge. However, following negotiations the defendant may have agreed, though without any admission as to the alleged infringement, to refrain from selling the two particular table cloths until 19 July 2001, when the application under encl. 10 was due to be heard. This may have led to the consent order being entered. Nevertheless, even upon the assumption that the aforesaid scenario transpired, yet the crux of the problem before the court in this contempt proceedings is that the precise nature and getup of the two impugned table cloths allegedly sold by the defendant, was not exhibited or appended in the consent order. Thus, exhibiting the table cloths in the affidavit supporting the application is insufficient as, in a charge for criminal contempt, it is the very court order rather than the cause papers that the court shall have exclusive reference to. Consequently, this court is left in the dark as to the precise nature of the alleged breach by the defendant upon which the contempt proceedings was founded.

This case is easy to decide, though not patently so, as counsel on both sides of the divide has each committed a cardinal error in analytical focus. Whilst the plaintiff's counsel has failed to incorporate in the consent order the precise design and getup of the table cloth that was the subject matter of the consent order – and this is a fatal omission in contempt proceedings – the defendant's counsel did not seek to impugn the content and nature of the consent order vis-à-vis the requirements in contempt proceedings; though no doubt he is precluded from questioning the consensual nature of the order. At this juncture, I may make an observation. It is such a pleasure, no doubt on rare occasions, to read or hear submissions of counsel who are well endowed with, I would term, the 'beautiful mind' (more precisely, the 'beautiful tapestry of an analytical mind') in cutting out or cutting through the chaff and seizing the kernel to lay out the gist in lucid logical sequence.

Thus, applying the above principles on citation for contempt that courts are obliged to follow, this court was unable to find the defendant in contempt of the consent order and dismissed the plaintiff's application in encl. 47 with costs.